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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,467	01/26/2001	Yoshiaki Tomomatsu	35.C15066	5464

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EXAMINER
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CHOOBIN, BARRY

ART UNIT	PAPER NUMBER
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2625

DATE MAILED: 12/05/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/769,467

Applicant(s)

TOMOMATSU, YOSHIAKI

Examiner

Barry Choobin

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21, 26-39, 45 and 46 is/are rejected.
- 7) ☒ Claim(s) 22-24 and 40-44 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3-4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

**Note that Applicant's claim of priority under International convention filed in paper #2 July 19, 2001 does not correspond to claim foreign priority as declared in DECLARATION AND POWER OF ATTORNEY FOR PATENT APPLICATION.**

Proper correction is required.

### *Information Disclosure Statement*

2. The information disclosure statements (IDS) submitted on December 10, 2002 and September 5, 2003 are in compliance with the provisions of 37 CFR 1.97. and 1.98. Accordingly, the information disclosure statements are being considered by the examiner.

### *Claim Objections*

3. Claim 2 is objected to because of the following: the phrase "and the like" renders the claim indefinite because the claim includes elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim unascertainable. See MPEP § 2173.05(d). Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-21, 26-39 and 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al (US 6,128,401) in view of Itako (US 6,393,140).

As to claim 1, Suzuki et al disclose an image processing apparatus comprising: judgment means for judging for each of predetermined areas whether or not an output requested image includes information indicating a judgment object image (column 1, line 66 through column 2, line 12).

However, Suzuki et al is silent about determination means for determining the predetermined area for each predetermined distance with respect to the output requested image.

But on the other hand, Itako discloses a Paper-like piece identifying method and device comprising: determination means for determining the predetermined area for each predetermined distance with respect to the output requested image (column 3, line 65 – column 4, line 12).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide the determination means for determining the predetermined area for each predetermined distance with respect to the output requested image of Itako with Suzuki et al in order to increase the identification accuracy and also to facilitate determination operation on the paper-like piece.

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As to claims 2 and 14, both Itako and Suzuki et al disclose judgment object image is an image of paper money, securities, and the like, which is prohibited by law from being printed (for example refer to Itako column 1, lines 5 – 13).

As to claims 3 and 15, Suzuki et al disclose information indicating the judgment object image is a visible or invisible digital watermark (column 5, lines 30 – 36, note that a watermark can be either visible or invisible).

As to claims 4 and 16, Suzuki et al disclose judgment means is executed by a printer driver (Fig.36, laser driver 4212).

As to claims 8 and 20, Suzuki et al in view of Itako disclose claim 1. However Suzuki et al is silent about plurality of judgment object images, the determination means determines a minimum distance among the predetermined distances for said plurality of judgment object images as the predetermined distance.

But on the other hand, Itako discloses plurality of judgment object images, the determination means determines a minimum distance among the predetermined distances for said plurality of judgment object images as the predetermined distance (column 18, lines 24 – 52).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide the plurality of judgment object images, the determination means determines a minimum distance among the predetermined

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distances for said plurality of judgment object images as the predetermined distance of Itako with Suzuki et al in order to increase the identification accuracy and also to facilitate determination operation on the paper-like piece.

As to claims 9 and 21, Suzuki et al disclose predetermined distance is determined also by considering that said judgment object image rotates (Fig. 14A)

As to claims 10 and 25, Suzuki et al disclose a result of said judgment that the judgment object image is included, any one of a processing of discontinuing output of the output requested image, a processing of changing the output requested image to another image and outputting the image, and a processing of informing that the output is impossible is performed (column 2, lines 38 – 44).

Claims 11-12 are similarly analyzed and rejected as claim 1.

As to claims 13, 26 and 27, these claims are similar to claims 1, 11 and 12 with an additional limitation requiring a unit of a band. According to the specification of instant application a band is defined as memory (see page 15, lines 5 – 10). Suzuki et al disclose a band including information indicating a judgment object (column 17, lines 42 – 51).

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As to claim 28, claim 28 is similarly analyzed and rejected as claim 1 except that drawing data as required in claim 28 is disclosed in Itako (column 1, lines 5 – 13).

As to claim 33, Suzuki et al disclose image data comprises an image with a small number of colors, said judgment means does not perform the judgment (column 5, lines 16 – 21).

As to claim 34, Suzuki et al disclose when as the result of the judgment by said judgment means the drawing data is not the image data, said judgment means does not perform the judgment (column 1, lines 15 – 17).

Claims 5-7, 17-20, 29-32, 35 – 39 and 45-46 are similarly analyzed and rejected.

***Allowable Subject Matter***

6. Claims 22-24 and 40-44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 6188787 to Ohmae et al is cited for Image recognition method and device and copier and scanner employing same.

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US 6542629 to Wu et al is cited for Digital imaging method and apparatus for detection of document security marks.

US 6567534 to Rhoads is cited for Method and system for watermark processing of line art images.

US 6304966 to Shimizu is cited for Data hiding method and system using statistical properties.

US 6289125 to Kato et al is cited for image processing device and method for identification.

US 6185404 to Hasuo et al is cited for image processing apparatus and method for generating a control signal.

#### **CONTACT INFORMATION**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barry Choobin whose telephone number is 703-306-5787. The examiner can normally be reached on M-F 7:30 AM to 18:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta can be reached on 703-308-5246. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Barry choobin



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November 19, 2003



Jayanti K. Patel  
Primary Examiner